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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,625	01/17/2001	Qi Wang	6956CIP	5289

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11/20/2002

Occidental Chemical Corporation
Patent Department
5005 LBJ Freeway
Dallas, TX 75244-6119

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 11/20/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,625

Applicant(s)

WANG, QI

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 4,7-9,11,13,15-19 and 22-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,10,12 and 14 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's affirmation of the election of Group I, species (a), subspecies (i), claims 1-3, 5, 6, 10, 12, 14, 20 and 21 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. This application contains claims 4, 7-9, 11, 13, 15-19 and 22-24, drawn to inventions nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
3. Due to amendments and persuasive arguments by applicant, the previous rejections based on White et al., Havens and GB 1560766 have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1-3, 5, 10, 12 and 14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the stabilizer compounds in the examples, does not reasonably provide enablement for the multitude of stabilizer compounds of claim 1, from which the remaining claims depend.

(thousands)

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 10, 12 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by Takayangi et al. (USPN 5,352,721).

In the abstract, col. 4, lines 19-23 and col. 5, lines 44-54, Takayangi et al. teach a thermoplastic resin composition comprising 1 to 30 part of a rubber such as a polyolefin type polymer, exemplified by a polyethylene/polypropylene copolymer (see examples), blended with 0.01 to 5 parts by weight of an acetal such as 7H,4H-1,3-dioxepine (corresponding to 0.03 phr (0.01/30) to 500 phr (5/1) based on 100 part of the rubber).

Thus, the requirements for rejection under 35 U.S.C. 102(b) are still met.

Allowable Subject Matter

8. Claims 20 and 21 are allowable over the prior art of record for reasons cited in the previous action.

9. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, for reasons cited in the previous action.

Response to Arguments

10. Applicant's arguments filed 10/1/02 have been fully considered but they are not persuasive.

11. Regarding the 112, 1st ¶ rejections, while applicant argues that the preparation of some of the stabilized is described in page 7 of the specification, applicant is required to provide enablement for **all** of the stabilizers claimed by applicant.

Regarding the declaration, the blanket statements of generic mechanisms and allegedly commercially available compounds in the declaration by Dr. Wang are not sufficient evidence that applicant, at the time the application was filed, provided a description the enables each and every claimed stabilizer.

For instance, there is no disclosure in the original specification as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to **make and/or use** the present polymer composition wherein the stabilizers are the fourth structure recited in claim 3 wherein the two R₂ form a ring and each R₁ represents a naphthalene group. Applicant's claims even encompass embodiments, in claim 1, in the stabilizer according to the middle cyclic structures between lines 4 and 5, wherein X

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is naphthalene or the various pyridine derivative moieties, and A is Sn, Si or B and R₁ represents 4 linked perylene groups (C₂₀ aryl groups) when n=4. Applicant states that some of the stabilizers are commercially purchased, however, the mere statement that the compounds are commercially available is not evidence in itself of such for all the stabilizers.

The first paragraph of 35 U.S.C. § 112 requires a reasonable correlation between the scope of what is claimed and the scope of enablement **provided by applicant's specification** to the person of ordinary skill in the art. **There is simply no recitation in the original specification to reasonably provide enablement for the multitude of stabilizer compounds recited in the claims.** There is nothing of record to indicate that the person of ordinary skill in the art would be enabled by the original specification to **make and use all** the claimed stabilizer compounds, commensurate in scope with these claims. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Applicant has not shown a representative sample of the stabilizers within the scope of the present claims.

Other than some non-specific mechanisms for preparing a **small** number of the compounds applicant intends to claim and the statement that **some** other small number of the compounds applicant intends to claim are commercially available, wherein the other unidentified compounds can be made by other unidentified but allegedly well-known techniques in the art, how to prepare **all** the compounds of claim 1 is simply not set forth in applicant's disclosure.

12. Regarding Takayangi et al., as stated above, Takayangi et al., still anticipates the elected claims. While applicant has removed polyethers and polyamides as representative polymer as recited in the claims, they are not excluded from being present in the composition along with the polyolefin polymers.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'KCE', with a long horizontal stroke extending to the right.

KCE
November 18, 2002